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PATENT
Attorney Docket No. 03806.0537
Customer No. 22,852

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Isabella ARNOULD-REGUIGNE *et al.*) Group Art Unit: 1647
Appln. No.: 10/072,900) Examiner: Rachel B. Kapust
Filed: February 12, 2002)
For: NUCLEIC ACIDS OF THE HUMAN)
ABCA12 GENE, VECTORS)
CONTAINING SUCH NUCLEIC)
ACIDS AND USES THEREOF)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO FURTHER RESTRICTION REQUIREMENT

In reply to the supplemental restriction requirement dated October 7, 2003, Applicants submit this response. This response is due November 7, 2003, and is timely filed.

SUPPLEMENTAL TRAVERSAL OF RESTRICTION REQUIREMENT

In the original restriction requirement dated May 16, 2003, the Examiner required restriction under 35 U.S.C. § 121 between Groups I-VII. Office Action dated May 16, 2003, page 2. The Office also required further restriction to "either (a) SEQ ID NO: 1 and 3 which encode SEQ ID NO: [5], or (b) SEQ ID NO: 2 and 4 which encode SEQ ID NO: 6." *Id.*

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Applicants elected, with traverse, **Group I**, claims 1-9, 12-13, 16-25, 31-32, and 40, drawn to nucleic acids, vectors, host cells, kits, and pharmaceutical compositions comprising the same, classified in class 536, subclass 23.1 and/or class 424/93.1; and **(a)** further drawn to either SEQ ID NO: 1 and SEQ ID NO: 3, which encode SEQ ID NO: 5. Response dated July 16, 2003.

In the May 16, 2003, Office Action, the Office asserted that the inventions of Groups "I and II and inventions I and VI are related as product and process of use." Office Action dated May 16, 2003, page 3. The Office's position is that restriction is proper because "inventions I-VII require different searches that are not coextensive." *Id.* Applicants disagree.

Applicants maintain their traversal of the restriction requirement for reasons of record, and as supplemented below. The Office has not shown there would be a serious burden to examine the full scope of SEQ ID NOs: 1-6 together. Serious burden is one necessary criterion for a restriction requirement. M.P.E.P. § 803. In particular, Applicants respectfully submit that a search of the subject matter of SEQ ID NO: 2, in addition to the subject matter of SEQ ID NOs: 4 and 6, would not be unduly burdensome because a search of the subject matter of SEQ ID NOs: 1, 3, and 5 would encompass the search of the subject matter of SEQ ID NOs: 2, 4, and 6 since SEQ ID NO: 1 encompasses SEQ ID NO: 2. Accordingly, the Sequences of group **(a)** encompass the Sequences of group **(b)** and therefore are co-extensive, contrary to the Office's position.

Applicants submit herein two (2) supplemental documents showing a comparison of nucleotide sequences SEQ ID NO: 1 vs. SEQ ID NO: 2 ("Comparison A"), and a

comparison of amino acid sequences SEQ ID NO: 5 vs. SEQ ID NO: 6 ("Comparison B"). Applicants point out that SEQ ID NO: 2 shares a very high degree of shared identity with SEQ ID NO: 1 except, in particular, for a single gap in SEQ ID NO: 2 between residues 4958 and 4959, which lacks 237 of the 9112 residues of SEQ ID NO: 1. See page 10 of Comparison A. Accordingly, this evidence clearly indicates that SEQ ID NO: 1 encompasses SEQ ID NO: 2 and therefore these sequences are co-extensive, contrary to the Office's position.

Similarly, the comparison of amino acid sequences SEQ ID NO: 5 vs. SEQ ID NO: 6, also shows a high degree of shared identity. For example, SEQ ID NO: 6 shows a single gap between residues 4740 and 4741, which lacks 237 of the 7785 residues of SEQ ID NO: 5. See pages 9 and 10 of Comparison B. Accordingly, this evidence clearly indicates that SEQ ID NO: 5 encompasses SEQ ID NO: 6 and therefore the sequences are co-extensive, contrary to the Office's position.

Therefore, Applicants respectfully request reconsideration and withdrawal of the finality of the restriction requirement of Groups (a) and (b), and that the Office examine at least SEQ ID NOs: 1-6 together in this application.

FURTHER RESTRICTION REQUIRED

In the further Restriction Requirement, dated October 7, 2003, the Office requires selection of additional nucleotide sequences from SEQ ID NOs: 7-38 for a total of 10 nucleotide sequences for further prosecution. Office Action, page 3.

(A) If as requested above the Office does agree to examine SEQ ID NOs: 1-6 together in this application (SEQ ID Nos: 5 and 6 being amino acid sequences),

Applicants elect 6 additional nucleotide sequences. In addition to nucleotide SEQ ID

NOs: 1-4, Applicants elect SEQ ID NOs: 7-12, for examination of a total of 10 nucleotide sequences.

(B) If the Office maintains the finality of the restriction requirement of Groups (a) and (b), then the Applicants elect 8 additional nucleotide sequences. In addition to SEQ ID NOs: 1 and 3, Applicants elect SEQ ID NOs: 7-14, for examination of a total of 10 nucleotide sequences.

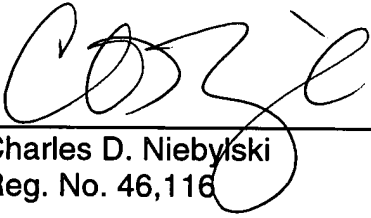
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 7, 2003

By: _____


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